

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BAC V. PHAM

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Appeal No. 1998-0587  
Application 08/385,253<sup>1</sup>

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ON BRIEF

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Before McKELVEY, Senior Administrative Patent Judge, and  
SCHAFFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellants' claims 1-32. Claims 1, 17 and 25 are independent claims.

References relied on by the Examiner

Squires et al. 1992 (Squires)	Patent No. 5,121,262	June 9,
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Abbott et al. 1994 (Abbott)	Patent No. 5,341,249	August 23,
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<sup>1</sup> Application for patent filed February 8, 1995.

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### The Rejections on Appeal

Claims 1-10, 12-23, 25, and 27-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Squires.

Claims 11, 24 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Squires and Abbott.

### The Invention

The invention is directed to a system for capturing an output signal from a selected one of a plurality of components which receive and process information read by an interactive element from a storage medium. Claims 17 and 25 specifically require a data capture circuit which includes an input multiplexer circuit and an output sample and hold circuit. As is described in the specification, based on the respective signals detected from the plurality of components in response to a test signal, optimization can be made with respect to the components. Independent claim 1 is representative and is reproduced below:

1. For use in a storage device including a storage medium for storing data, an interactive element for reading information from and writing information on the storage medium and a processor for performing control functions in the storage device, a read channel, which comprises:

a set of electronic components for receiving and

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processing information read by the interactive element from the storage medium;

each component of the set of electronic components having an output and being coupled in a predetermined arrangement to other components of the set of electronic components to process the read information;

a data capture circuit including an input circuit and an output circuit;

the input circuit coupled to the output of each component of the set of electronic components;

the output circuit coupled to the input circuit to capture a signal from a preselected one of the outputs coupled to the input circuit, and being adaptable to transfer the captured signal to the processor.

#### Opinion

The rejection of claims 1-10, 12-23, 25, and 27-32 under 35 U.S.C. § 103 as being unpatentable over Squires cannot be sustained. The rejection of claims 11, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Squires and Abbott also cannot be sustained.

A reversal of the rejection on appeal should not be construed as an affirmative indication that the appellant's claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is

based.

Each of appellant's independent claims 1, 17 and 25 includes an input circuit which is coupled to the respective outputs of a set of electronic components. The difference between the appellant's claimed invention and Squires is not disputed. The examiner acknowledges that Squires "only discloses one output coupled to the input circuit" (answer at pages 4, 7 and 8) and "does not disclose a signal from a preselected one of the outputs coupled to the input circuit" (answer at page 3) (emphasis added).

According to the examiner, however, "[a]dding additional outputs will allow for individual optimization of each electronic component" (answer at pages 4, 7 and 8). The examiner cites no evidence to support this finding which appears to be based solely on hindsight in light of the appellant's own disclosure. Any optimization revealed by Squires, as applied by the examiner, is based on a single output collectively generated by a set of electronic components. The examiner has not demonstrated that Squires would have reasonably suggested to one with ordinary skill in the art that a separate output should be received by the input

circuit from each component within the set of electronic components that process information read from a storage medium.

The examiner further takes the position that "adding additional outputs is merely a duplication of parts" (answer at pages 4, 7 and 8). But going from a system having a single output produced by a set of components which interact with each other to a system having separate outputs from each of the components within the set of components is not a mere duplication of parts. A mere duplication of the output signal would have resulted in two identical signals being produced by the same set of components and they cannot be regarded as separate outputs from respective parts within the set. The appellant is correct that the one output from Squires does not distinguish between the functions of the individual components within the set of components but represents an amalgamation of the output functions of all the components within the set.

For the foregoing reasons, we do not sustain the rejection of claims 1-10, 12-23, 25, and 27-32.

As for dependent claims 11, 24 and 26, the examiner's reliance on Abbott does not make up for the deficiency of

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Squires. Abbott was applied only to meet the further feature of partial response maximum likelihood detection channel added by claim 11 to claim 1, claim 24 to claim 17, and claim 26 to claim 25. Accordingly, we also do not sustain the rejection of claims 11, 24 and 26.

Conclusion

The rejection of claims 1-10, 12-23, 25, and 27-32 under 35 U.S.C. § 103 as being unpatentable over Squires is reversed.

The rejection of claims 11, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Squires and Abbott is also reversed.

REVERSED

FRED E. McKELVEY, Senior	)
Administrative Patent Judge	)
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RICHARD SCHAFER	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JAMESON LEE	)	
Administrative Patent Judge	)	



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McDERMOTT WILL & EMERY  
600 13th Street, N.W.  
Washington, D.C. 20005